

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 109

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RICHARD T. FLANDERS et al.

Junior Party,¹

v.

DAVID R. MOORMAN et al.

Senior Party.²

Interference No. 103,891

Before CALVERT, PATE, and HANLON, ***Administrative Patent Judges***.

PATE, ***Administrative Patent Judge***.

¹ U.S. Application 08/292,157, filed August 17, 1994.
Assignors to Abbott Laboratories.

² U.S. Patent 5,356,782, granted October 18, 1994, based on
Application 07/940,059, filed September 3, 1992. Assignors to
Roche Diagnostics Corporation.

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FINAL DECISION UNDER 37 CFR § 1.658(a)

This is a final decision in Interference No. 103,891. The junior party inventors are Richard T. Flanders, Marvin I. Berman, Stacey L. Ishman, Mary L. Lemens, Neal A. Siegel, Kimberly A. Snyder, Vincent A. Varitek, and Stephen W. Worobec. They are the inventors of application S.N. 08/292,157 filed on August 17, 1994. The Flanders et al. real party in interest is Abbott Laboratories. The senior party inventors are David R. Moorman, David J. Ledden, David D. Webster, and Brian A. Heald.³ The involved senior party patent is U.S. Patent No. 5,356,782 issued October 18, 1994. The filing date is September 3, 1992. The Moorman real party in interest is Roche Diagnostics Corporation.

The claimed invention is directed to a test strip for carrying out an analytical assay in a clinical setting. The test strip is provided with both a negative control and a positive control. A negative control is a control signal which will never give a signal whether the substance tested for, the analyte, is present or not. The positive control tells the user the device is functional. The positive control should give a signal to the

³ Henceforth, the parties will be referred to in the singular, i.e., Flanders and Moorman.

user any time the strip is used whether the analyte is present or not. Thus, the invention comprises a test strip with a negative control, a test zone where the analyte of interest is tested for, and a positive control. The count corresponds exactly to the Moorman patent claim 1 and reads as follows:

Count 1

An apparatus for determining an analyte of interest in a liquid sample comprising an absorptive material and having a plurality of zones in the direction of fluid flow, wherein:

(i) a first negative control zone of said absorptive material contains an immobilized reactant which does not bind to said analyte of interest;

(ii) a second analytical zone of said absorptive material contains an immobilized reactant which specifically binds to said analyte of interest; and

(iii) a third positive control zone of said absorptive material contains both (a) an immobilized reactant which specifically binds to said analyte of interest, and (b) a portion of the analyte of interest in solubilizable form, wherein said portion of the analyte is solubilized when contacted with the liquid sample and reacts with the immobilized reactant of said third zone.

The claims of the parties that correspond to the count are:

Flanders: Claims 1-13

Moorman: Claims 1-30

The specific embodiment disclosed by both parties is a test strip for testing for ***Streptococcus pyogenes***. MX-1, ¶ 2.⁴

⁴ The Moorman record and exhibits will be abbreviated MR and MX- followed by the appropriate page or item number.
(continued...)

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The analyte of interest is a molecule known as "Group A Streptococcal carbohydrate." Therefore, in the record, the molecule is called "Strep Group A," "GAS-CHO"⁵ or "GAS." MX-1, ¶ 2.

Background

The interference was declared on June 5, 1997 with Flanders as junior party. Both parties filed motions for judgment against their opponent under 37 CFR § 1.633(a) alleging unpatentability based on what is termed "Concept S." Concept S was a presentation made by Flanders' assignee's marketing department on July 6, 1989. Both motions were dismissed without prejudice to being renewed. The motions were renewed by both parties, and a decision on the renewed motions was deferred to this final hearing.

Flanders also filed a motion under 37 CFR § 1.634 to correct the inventorship of its involved application.

Both parties filed records. Flanders filed an opening brief and a reply brief. Moorman filed an opening brief. Both parties were represented by counsel at an oral hearing.

⁴(...continued)
Likewise, the Flanders record and exhibits are abbreviated FR and FX-, respectively.

⁵ **Group A Streptococcal Carbohydrate.**

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Issues

The following issues have been raised by the parties in their briefs:

- a) the status of Concept S as prior art under either 35 U.S.C. §§ 102(a) or 102(b);
- b) the patentability of the claims of both parties over Concept S if it is determined to be prior art;
- c) the Flanders motion under 37 CFR § 1.634 to correct inventorship;
- d) the parties' respective cases for priority of invention; raised in Flanders' reply brief;
- e) whether the embodiment relied on for Moorman's priority proof is within the scope of the count; raised subsequent to Flanders' reply brief;
- f) the Moorman motion to strike portions of Flanders' reply brief or in the alternative permit filing of a Moorman surreply brief; and;
- g) certain papers filed after oral hearing.

Moorman's Motion to Strike Portions of Flanders' Reply Brief

Subsequent to the filing of Flanders' reply brief for final hearing, Moorman filed a motion to strike portions of

Flanders' reply brief or in the alternative permit filing of a Moorman surreply brief. Flanders filed an opposition to these alternative motions, and Moorman filed a reply. Moorman specifically requests that sections III through VI of Flanders' reply brief be stricken. Moorman states that these sections contain an extensive attack on Moorman's conception and reduction to practice including an analysis of Moorman's evidence. We agree as to what they contain.

Moorman first argues that Flanders' failure to cross-examine raises a presumption that the testimony is accurate. However, Moorman misapprehends the nature of Flanders' attack. Flanders' argument is that even if all of Moorman's testimony is true, Moorman still has not established a necessary factual basis for conception or reduction to practice. Flanders is under no obligation to patch up holes in Moorman's case by cross-examination.

Next, Moorman argues that Flanders' brief should be stricken, since Flanders should have attacked Moorman's priority case in Flanders' opening brief. For this premise, Moorman cites 37 CFR § 1.656(b)(6) and particularly the case of **Suh v. Hoefle**, 23 USPQ2d 1321, 1323 (Bd. Pat. App. & Int. 1991). In **Suh**, the Board had held that the junior party should have raised the issue that the senior party's case for priority was defective for

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hearsay in the junior party's opening brief. The difficulty with such a holding is that the junior party must rebut the senior party's priority case even before it is known what the senior party is relying on to prove priority of invention.

Accordingly, when the interference rules were amended in 1995, the commentary interpreted 37 CFR § 1.656(b)(6) to modify the holding in *Suh*. Specifically, the commentary states that current rule 37 CFR § 1.656(b)(6) "does not expressly require and was not intended to imply, that the opening brief of the junior party must address the evidence of any other party with respect to the issue of priority or any other issue." 1173 Off. Gaz. Pat. & Trademark Office 60 (Apr. 11, 1995); 60 Fed. Reg. 14516 (Mar. 17, 1995). Thus, the precise issue we are faced with in this interference was contemplated when the rules were amended in 1995.

Therefore, the motion to strike a portion of the Flanders reply brief is DENIED.

The motion to file a surreply brief is not specifically provided for in the rules. However, the same commentary to the rule change we quoted above indicates that if the junior party's reply brief is believed to include a new argument in response to the case-in-chief of the senior party as presented in the senior party's main brief, the senior party may move for leave to file a

reply to the junior party's reply brief. **See Id.** Presumably, the commentator is of the view that these senior party replies should be liberally admitted. As discussed below, Moorman's surreply is a combination of rearguing and filling holes in his priority case-in-chief along with an actual response to the junior party's new argument. We would be fully justified in denying consideration to the entire surreply. Nonetheless, in the interest of justice, we will admit the portions of Moorman's surreply brief which we consider are directed to the specific argument made in the Flanders reply. The motion for leave to file a surreply brief and have it considered at final hearing is GRANTED-IN-PART as indicated below.

Moorman's surreply brief is of two separate parts intermixed together. In one part, Moorman reargues his priority case.⁶ This portion of the surreply is completely unacceptable,

⁶ As some examples of how the surreply brief reargues Moorman's priority case: Moorman's main brief does not apply Moorman's proofs to the terms of the count. Moorman's sole discussion or explanation of how the record supports the count is the first paragraph of page 5 of his main brief. It does not mention the alleged reductions to practice of November 11 or November 21, 1988 which are discussed for the first time on page 4 of the surreply. Exhibits 9-13 are not discussed in the main brief, but they are relied on to prove priority in the surreply. Moorman's surreply relies extensively on MX3 as a reduction to practice. We do not believe MX3 is even mentioned in the Moorman main brief.

inasmuch as Moorman must argue his priority case in his main brief. In the second part, Moorman responds specifically to the argument of Flanders respecting whether Moorman has shown a reduction to practice of that portion of the count that requires the analyte of interest in solulizable form to be part of the positive control. As to the first part, it is entitled to no consideration, whatsoever. For example, we will not consider the work done in November argued at pages 4-7 of the surreply and thereafter. This material is part of Moorman's case-in-chief and must be in the main brief to be entitled to consideration. Additionally, any argument directed to the equivalence of Moorman's case-in-chief and Flanders' case-in-chief was ripe for argument in Moorman's main brief and is not entitled to consideration when presented in a surreply. This applies to section C. of the surreply found on pages 7-10. Furthermore, on page 13, Moorman offers a count construction. Moorman did not construe the count in his main brief. This material will not be considered. As to the other part of the surreply, we will review these specific arguments of Moorman when we consider Moorman's priority case.

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Papers Filed After Oral Hearing

Notwithstanding 37 CFR § 1.654(d), the parties have filed the following papers after final hearing: Letter of Correction filed by Moorman; Flanders' Response to the Letter of Correction; and Moorman Reply to the Flanders Response. The original Moorman Letter purports to correct an impression that Moorman alleges was given to the Panel when party Flanders distributed explanatory materials during oral hearing.

None of the papers filed after final hearing is entitled to consideration under the rules. They have not been considered. This interference has been decided on the briefs.

The oral argument is held only for the parties to emphasize points made in a brief. ***Rosenblum v. Hiroshima***, 220 USPQ 383 (Comm'r. Pats. & Trademarks 1983) (The purpose of oral argument at final hearing is to emphasize and clarify written argument in the brief.) ***Compare In re Chiddix***, 209 USPQ 78, 79 (Comm'r. Pats. & Trademarks 1980). Explanatory materials presented to the Board at any hearing are not evidence used in deciding the case.

Concept S

As argued in both main briefs, the parties are now in agreement that the Concept S marketing presentation is prior

art under 35 U.S.C. § 102(a) and not § 102(b).⁷ Both parties further agree that if the Concept S presentation were prior art under § 102(b) it would be a bar to patentability of either side's claims.⁸ Notwithstanding the agreement of the parties as to the applicability of § 102(a) and not § 102(b), patentability under both paragraphs of § 102 has been raised and developed in the record. It is our duty to consider both issues. As our reviewing court stated in *Perkins v. Kwon*, 886 F.2d 325, 328-29, 12 USPQ2d 1308, 1311 (Fed. Cir. 1989):

The Board, by resolving both priority and patentability when these questions are fully presented, settles not only the rights between the parties but also rights of concern to the public. The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity that arise before the PTO. To do otherwise is contrary to the PTO's mission to grant presumptively valid patents, 35 U.S.C. § 282, and thus disserves the public interest.

The following are our findings of fact with respect to the Concept S alleged prior art. Sometime prior to July 1989, Abbott Laboratories, Flanders' assignee, retained Lawrence

⁷ Flanders' brief at 13. Moorman brief at 9.

⁸ The Concept S presentation dated July 6, 1989 is more than a year before either party's filing date.

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Hammond to conduct marketing research with respect to prospective products. FR1-2. Hammond was an independent marketing specialist. On July 6, 1989, Hammond held a marketing study at the facilities of National Data in Northfield, Illinois. FR2. The marketing study presented two prospective products, in detail, to the attendees. Their reactions to the products were surveyed. The attendees were nurses and medical technicians, the target users of the prospective products. FR2. The attendees were under no obligations of confidentiality. FR2. Hammond provided a summary of the presentation, and it is of record as FX-1. FR2. Audio and video recordings of the study were also made. FX-1 at 3.

Exhibit FX-1 is Hammond's summary of the marketing presentation, and it is discussed in detail by Flanders' expert Dr. Salvati. In the presentation made to the attendees of the marketing study were two types of chromatographic assays. FX-1. These assays test for the presence of ***Streptococcus pyogenes***, commonly called strep. FR5, ¶ 3. The two assay devices were called Concept N and Concept S. FR2, ¶ 5. Concept S is the alleged prior art.

Concept S is portrayed on the two pages after page 17 of FX-1. On the first page, the contents of a Concept S kit are

shown. These include a swab, an extraction tube--where reagent and specimen mixing occurs, three numbered reagents, and a reaction disc. The reaction disc is generally square and has a sample window in which the specimen-reagent mix is placed. Taking up a major portion of the disc's surface is the area containing the various windows of the test. In the central portion of the disc there is a results window. To the right of this window are two smaller windows one above the other. The top small window is the positive control window; the lower small window is the negative control window. Diagonally across from the sample window where the specimen is introduced, in the other corner of the disc, is the end of assay window. The procedure for use of the Concept S kit is shown on the next page of FX-1.

The last page of FX-1 is a description of how the Concept S test results would be interpreted. Simply put, if an indication appears in the upper small window beside the results window but not in the lower small window beside the results window, the test was performed accurately, whether the test results are indicated as positive or negative. If two indications appear in both small windows, the test is falsely positive. If no indications appear in the two small windows, the test is a

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false negative one. These three pages constitute the entirety of the Concept S shown to the attendees at the marketing study.

Anticipation is a question of fact. ***Glaverbel Societe Anonyme v. Northlake Mktg. & Supply***, 45 F.3d 1550, 1554, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). We are in agreement with the parties that the claimed subject matter of the parties was not in public use based on the Concept S presentation. As such, no device conforming to the claimed invention had been constructed or was in existence to use at the time of the presentation. Nor was the claimed subject matter on sale. The moving parties have proved neither an offer for sale or that the claimed subject matter was reduced to practice or ready for patenting. ***See Pfaff v. Wells Elecs., Inc.***, 525 U.S. 55, 67-68, 48 USPQ2d 1641, 1646-47 (1998) ("First, the product must be the subject of a commercial offer for sale" and "the invention itself must also have been "ready for patenting" at the time of the offer or sale--e.g., the invention must have been reduced to practice or embodied in "drawings or other descriptions . . . that [are] sufficiently specific to enable a person skilled in the art to practice the invention.")). Accordingly, we concur with the parties that Concept S is, at most, prior art under 35 U.S.C. § 102(a).

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Additionally, an anticipatory reference must be enabling, *see Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), **cert. denied**, 482 U.S. 909 (1987), so as to place one of ordinary skill in possession of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Thus for either party to prevail on the motion of unpatentability they must show that Concept S was an enabling disclosure of the claimed subject matter. This they have not done. In fact, Dr. Salvati does not discuss whether the Concept S disclosure would have enabled one of ordinary skill to practice the invention without undue experimentation. Actually, Dr. Salvati does not mention undue experimentation. This reason alone is enough to deny the motion for unpatentability.

Furthermore, during cross-examination, Dr. Salvati confirmed that the presentation included no discussion of reagents, locations of reagents, or what they may or may not have been. No explanations of principles [of operation] were presented to those interviewed.

Flanders admits, when arguing in a different context, that a particular type of positive control is needed to satisfy the count. Flanders' reply brief at 5. Flanders further admits

that there are several ways to implement a positive control. ***Id.*** We note nothing in the Concept S presentation that states that the analyte of interest, in solubilizable form, is placed on the test strip for a positive control. We further note the conclusion of Dr. Salvati in the last sentence of paragraph 9 of his declaration at FR7. Dr. Salvati states that the positive control one would use on the device of the marketing summary would have been a control with an "on board" reactant. This is a conclusory statement not supported by any facts stated by Dr. Salvati. Consequently, it is difficult to see how Concept S can be an enabling disclosure as required by the jurisprudence.

Our finding with respect to Concept S is that although there was public knowledge of a test strip in July 1989, that knowledge would not have enabled one of ordinary skill to make and use the invention. The presentation of Concept S was not a reference under §§ 102(a), (b), or 103 with respect to the claimed subject matter. The 37 CFR § 1.633(a) motions for judgment based on unpatentability with respect to Concept S are DENIED.

Flanders' Case for Priority of Invention

As the junior party in an interference between co-pending applications, junior party Flanders bears the burden

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of proving priority by a preponderance of the evidence. **See Cooper v. Goldfarb**, 154 F.3d 1321, 1326, 47 USPQ2d 1896, 1900 (Fed. Cir. 1998)(**quoting Scott v. Finney**, 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994)). Priority, conception, and reduction to practice are questions of law which are based on subsidiary factual findings. **Cooper** at 1327, 47 USPQ2d at 1901. Flanders' case of priority is bottomed on an actual reduction to practice. In order to establish an actual reduction to practice, the inventors must prove that: (1)they constructed an embodiment or performed a process that met all the limitations of the interference count; and (2) they determined that the invention would work for its intended purpose. **Id.**

The following are our factual findings respecting Flanders' case for priority. Beginning in about June 1988, Dr. Varitek commenced work on an assay test strip with a positive and negative control. FR135. FX-19 at 61 shows a sketch of a test strip. The sketch was made by Dr. Varitek on June 1, 1988. The sketch shows a strip, the top portion of which is divided longitudinally, with two columns--the left column marked PC and the right column marked NC. About two-thirds of the way down the strip is a cross. Below the sketch of the strip is a table that shows the possible combinations of readings. Finally, below the

table is a written explanation of what the results in the table represent. The disclosed test strip does not have the various test zones arrayed in the flow order as required by the count.

In November 1988, Dr. Varitek and his laboratory assistant Ms. Laurie Watts nee Powers⁹ commenced experiments on an assay test strip they called "Strep Strip Pack." FR13; FR31; FR137. Ms. Watts describes the test strip as it was described to her in ¶ 4 of her declaration. This description includes the idea that the test "zones would be positioned on the strip such that the flow of applied fluid would pass though [sic, through] each zone by capillary action." FR14.¹⁰ Although no contemporaneous drawing describes the test strip, Watts provides the necessary corroboration.¹¹ Thus, we credit Flanders with a

⁹ Hereinafter, Ms. Watts.

¹⁰ The date in the first line of ¶ 4 of Ms. Watts' declaration at FR14 should read November 9, 1988 not 1989. This was corrected during cross-examination at FR 31.

¹¹ Moorman argues that there is no contemporaneous drawing of the conception. In the interference **Lustig v. Legat**, 154 F.2d 680, 682, 69 USPQ 345, 348 (CCPA 1946), Lustig argued that the Board improperly awarded priority to Legat upon a record most of which consisted of oral testimony and which was adduced a number of years after the events were alleged to have happened. Lustig further complained of a lack of sufficient documentary evidence, particularly records kept by corporations such as that of Legat's assignee relating to shop drawings, time cards, etc.

In **Lustig**, 154 F.2d at 682, 69 USPQ at 348, the court held:

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conception of the subject matter of the count on November 11, 1988.¹²

From November 9, 1988, work began on reducing the strep strip pack invention to practice. FX-17 is Ms. Watts' notebook of the work she performed in reducing the invention to practice. In Ms. Watts' declaration from FR15-18, Ms. Watts describes her activities and experiments by date. In our view, this amounts to reasonably continuous activity.

On December 22, 1988, Ms. Watts performed experiments with a test strip according to the count of the interference.

¹¹(...continued)

It is too well settled in patent law to require extended discussion or citation of authority in support thereof that one may prove his priority of invention by oral testimony alone. It is true the courts scrutinize such testimony with care because of the possibility of fraud, mistake or bad memory bringing about improper results, but no court, to our knowledge, has ever held that one cannot establish priority by oral proof, and it very often occurs that priority is established in a most convincing way by oral proof, particularly where there is lack of inconsistency in the testimony of the witnesses and where there are related facts shown in the record, as are shown in the instant one, corroborating such testimony. Moreover, Legat's instant record contains considerable documentary evidence which supports and strengthens and gives convincing character to the testimony of Legat and his witnesses.

Accord Sands v. Bonazoli, 223 USPQ 450, 451 (Bd. Pat. Int. 1983).

¹² Party Flanders is restricted by its preliminary statement to a conception date no earlier than November 11, 1988.

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At the top of page 84 of FX-17, a schematic test strip is shown. On the left side is a spot of APS antigen and further up is an immobilized antibody. This forms the positive zone within the scope of the count. To the right, is one spot of negative rabbit Ig for the negative zone, and below both positive and negative zones is a jetted stripe of test zone. FR19. Based on this evidence, we credit Flanders with a corroborated reduction to practice on December 22, 1988. Corroboration is furnished by Ms. Watts, a non-inventor.

Finally, we note the statement in Moorman's brief that Moorman has no issue with Flanders' reduction to practice on December 22, 1988. Moorman brief at 8-9.

Moorman Priority Case

The following are our findings of fact with respect to Moorman's priority case. Starting in late 1987, Moorman began work on an on board control test strip device for medical diagnosis purposes. MR1. Specifically, he worked on a strip to detect Group A Streptococcal carbohydrate, a molecule indicative of a streptococcal infection in humans. *Id.*; MR16-17. Moorman supervised two assistants--Lisa Terrett and Dilip Pandya. MR2; MR3, ¶ 6. In early April 1988, Moorman communicated a test strip

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concept to Lisa Terrett. MR2, ¶ 4. As described in ¶ 4 of Moorman's declaration, the strip has one zone to react to the specific analyte of interest. A second zone is a so-called positive zone, and a third zone is the so-called negative zone. However, ¶ 4 does not state that the zones are in a direction of fluid flow, nor does it state that the positive zone contains immobilized analyte of interest in solubilizable form. MR2, ¶ 4.

Moorman ¶ 10 describes an experiment on April 13, 1988 in detail. The experiment is also described at ¶ 16 of Terrett's declaration. MR21. Terrett's laboratory notebook pages describing the experiment are at MX-4. Page 2 of the notebook shows a successful experiment of a test strip that has both positive and negative controls. MX-4 at 2.

Junior party Flanders argues, in reply, that the test of April 13, 1988 cannot be considered a reduction to practice, because there is no indication in the Moorman record that the Strep A antigen added to the positive control zone as the analyte of interest is in solubilizable form as required by the count in interference. Thus, we are called on to construe the terminology of the count.

The proper interpretation of a count is a question of law. **Credle v. Bond**, 25 F.3d 1566, 1571, 30 USPQ2d 1911, 1915

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(Fed. Cir. 1994) (**citing Davis v. Loesch**, 998 F.2d 963, 967, 27 USPQ2d 1440, 1444 (Fed. Cir. 1993)). The established standard of count interpretation is that interference counts are to be given the broadest interpretation which they will reasonably support. **Mead v. McKirnan**, 585 F.2d 504, 507, 199 USPQ 513, 515-16 (CCPA 1978). Terms in the count are to be given their ordinary and accustomed meaning. **See Johnson Worldwide Assocs. Inc. v. Zebco Corp.**, 175 F.3d 985, 990, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (**quoting Renishaw PLC v. Marposs Societa Per Azioni**, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998)). Resort to a specification from which a claim on which the count is based or resort to extrinsic evidence is only appropriate or necessary when an ambiguity exists in the count. If an ambiguity is found, resort may be had to the specification of the patent from which the claims originate to resolve the ambiguity. **See In re Spina**, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992). Determination of the existence of an ambiguity requires consideration of both the language of the count and the reasonableness of the arguments indicating the count has different meanings. **Kroekel v. Shah**, 558 F.2d 29, 31-32, 194 USPQ 544, 546 (CCPA 1977). The mere fact that the parties ascribe different meanings to a count or that the count is readable on more than one embodi-

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ment does not render the count ambiguous. *See id.* at 32, 194 USPQ at 547.

We do not find the term "solubilizable" to be at all ambiguous, and thus we give it its ordinary and accustomed meaning. We construe the term as capable of entering a solution. As such, the count requires the analyte in subparagraph iii) of the count to be able to enter into solution when the liquid sample contacts it.¹³

We agree with Flanders that the Moorman record does not expressly state that the Strep A antigen added to the positive control is in solubilizable form.¹⁴ Furthermore, if the Strep A

¹³ At oral hearing, Moorman advanced an interpretation that "solubilizable" could mean that the antigen was in solution when it was applied to the test strip during manufacture and did not require the ability to dissolve when contacted by the liquid sample. We are of the view that this construction of the subject matter of the count is against the plain language thereof. The count requires the third zone of the absorptive material to "contain[s]" a portion of the analyte in solubilizable form. If the antigen is prereacted with the strep antibody when it is placed as a dot thereon, it would not be contained in the absorptive material in solubilizable form.

¹⁴ We are in agreement with the Moorman argument, found only in the surreply, that MX3 does state that Ms. Terrett added the strep antigen to the positive test zone on April 5, 1988. However, it neither states where on the zone it was added, i.e., upstream from or on the antibody, nor whether it was contained in the strip in solulizable form. However, we do note that MX4 from April 13, 1988 specifically states that the GAS-CHO was placed on the latex dot. MX4 does not indicate a change in experimental procedure from the prior experiment of MX3. This leads us to believe that it was more likely than not that the GAS-CHO antigen
(continued...)

antigen added to the positive control is inherently solubilizable, then Moorman has a duty of showing that this is the case, for Moorman must affirmatively prove that he reduced to practice every element of the count for priority purposes. We merely note that Terrett states that the Strep A antigen is placed on the latex dot¹⁵ which would imply prereaction rather than placing the antigen upstream in a flow direction therefrom. Moreover, Moorman, in arguing that not all of the Strep A antigen is prereacted with the strep antibody in the positive control zone, confirms that Flanders' theory of prereaction has merit. If it is indeed true that not all Strep A antigen is prereacted leaving some to solubilize, then it is incumbent on Moorman to so state and prove on the record. This is part of Moorman's burden of proof for his case-in-chief. This Moorman has not done.¹⁶

¹⁴(...continued)
was placed on the latex dot on April 5, 1988, also. In any event, Moorman has the burden of showing that all features of the count were present on April 5, 1988, and MX3 does not affirmatively confirm that every feature of the count was reduced to practice.

¹⁵ The latex already contains the strep antibody.

¹⁶ Moorman discusses, but is not able to explain, MX15 which clearly states, "[d]uring the impregnation, antibody-latex conjugate and analyte diffuse and bind to each other to form a specific analyte-antibody-latex complex in the positive zone." This is Moorman's description of the invention in an invention disclosure, and it supports Flanders' argument respecting no proof of solulizable analyte in the positive test zone.

We further agree with Flanders that Moorman has not laid out in his brief at the first paragraph of page 5 how any of the alleged reductions to practice satisfy the requirements of the count. Instead, this panel is expected to dig through Moorman's record to establish Moorman's priority case.¹⁷ For example, Moorman's brief refers to a reduction to practice on June 14 and references ¶ 41 of Lisa Terrett's declaration at MR23. However, ¶ 41 is but one sentence long. It cannot possibly explain how MX-18 establishes a reduction to practice.¹⁸ Likewise, note the alleged reductions to practice on June 23, July 1, July 28, August 19, September 21, and November 4.¹⁹ The alleged

¹⁷ Conclusions of fact and law made without appropriate citation to the record or citation of authority will be taken as mere attorney argument. *Cf. Ex parte McCullough*, 7 USPQ2d 1889, 1892 (Bd. Pat. App. & Int. 1988); *Ex parte Meyer*, 6 USPQ2d 1966, 1968-69 (Bd. Pat. App. & Int. 1988); *In re Mehta*, 347 F.2d 859, 866, 146 USPQ 284, 289-90 (CCPA 1965).

¹⁸ The significance of documentary and other exhibits must be discussed with particularity by a witness during oral deposition or in an affidavit. *See* Notice of Final Rule, 49 Fed. Reg. 48416, 48428 (Dec. 12, 1984), *reprinted in* 1050 Off. Gaz. Pat. Office 385, 397 (Jan. 29, 1985); *Popoff v. Orchin*, 144 USPQ 762 (Bd. Pat. Int. 1963) (unexplained experimental data should not be considered); *Chandler v. Mock*, 150 F.2d 563, 66 USPQ 209 (CCPA 1945) (records standing alone were held to be meaningless); and *Smith v. Bousquet*, 111 F.2d 157, 45 USPQ 347 (CCPA 1940) (unexplained tests in stipulated testimony are entitled to little weight). *See also In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974) and *Triplett v. Steinmayer*, 129 F.2d 869, 54 USPQ 409 (CCPA 1942).

¹⁹ Actually, the alleged reductions to practice on these
(continued...)

reduction to practice on October 7 is described in two sentences. Similarly, it does not establish a reduction to practice of all elements of the interference count. These are all Moorman's alleged reductions to practice from his brief. Finally, the failure of Flanders to cross-examine does not relieve Moorman of his burden of proving priority. ***Ganguly v. Sunagawa***, 5 USPQ2d 1970, 1973 (Bd. Pat. App. & Int. 1987).

Moorman's alleged reduction to practice of April 13, 1988 is the only Moorman alleged reduction to practice described in any detail. Flanders has correctly pointed out that Moorman does not affirmatively state or prove that the Strep A antigen, the analyte of interest, in the positive control zone, is in solubilizable form as required by the interference count. All others of Moorman's alleged reductions to practice are simply not discussed with any particularity whatsoever. Given the situation outlined above, we are unable to credit Moorman with a reduction to practice at any time prior to his constructive reduction to practice at his filing date of September 3, 1992.

¹⁹(...continued)
dates are discussed in greater detail in the Flanders reply brief than in Moorman's brief. Flanders' reply also discusses at 10-14 various allegations in Moorman's statement of facts that Moorman himself does not rely on for reduction to practice in the body of his brief.

Interference No. 103,891

Flanders' Motion for Inventorship Change under 37 CFR § 1.634

Moorman does not oppose Flanders' request for a change of inventorship in his brief. Flanders has provided evidence the misjoinder was without deceptive intent. Accordingly, the motion under 37 CFR § 1.634 is GRANTED. The interference will be redeclared with the junior party inventors corrected as per Flanders' motion.

Conclusion

We have first considered the Concept S prior art and found it to be non-enabling. Accordingly, it does not render any of either party's claims unpatentable.

With respect to priority, we have accorded Flanders, the junior party, a date of reduction to practice as of December 22, 1988. This antedates the senior party's filing date. When we considered the senior party's priority case, we were unable to credit the senior party with a reduction to practice earlier than that filing date of September 3, 1992. Flanders has won the priority contest. Therefore, we will enter judgment hereinbelow in favor of Flanders, the junior party.

Interference No. 103,891

Judgment

The interference is being redeclared in a separate paper.
Judgment in Interference No. 103,891 is entered in favor of Richard T. Flanders and Vincent A. Varitek, the junior party. Richard T. Flanders and Vincent A. Varitek are entitled to their application claims 1-13, which claims correspond to the count in interference. Judgment is entered against David R. Moorman, David J. Ledden, David D. Webster, and Brian Heald, the senior party. David R. Moorman, David J. Ledden, David D. Webster, and Brian Heald, are not entitled to their patent claims 1-30, which claims correspond to the count in interference.

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	
ADRIENE LEPIANE HANLON)	
Administrative Patent Judge)	

WFP:psb

Interference No. 103,891

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